

REMARKS

Reconsideration and allowance of this application are respectfully requested in view of the foregoing amendments and the following remarks.

Claim Rejections Under §102:

Paragraph 2 of the Office Action rejects claims 1-27, 29, 30, 32, 34-36, 38, 40, 41, 49 and 51 under 35 U.S.C. 102(b) as being anticipated by Diamond (United States Patent No. 6,698,653). This rejection is respectfully traversed.

Applicant notes that the Office Action has mistakenly characterized Diamond as a §102(b) reference. In order for Diamond to be a proper § 102(b) reference, it must have been issued or published more than one year prior to the filing date of the present application. The present application was filed on July 9, 2003 and claims priority to provisional application 60/394,241, filed July 9, 2002. Diamond issued on March 2, 2004 and no earlier publication date is indicated. Accordingly, Diamond is not a proper § 102(b) reference. Diamond was filed before the earliest priority date for the present application on October 28, 1999. Because Diamond issued after the U.S. filing date of the present application, but was filed before the earliest priority date for the present application, any rejection based on Diamond must be under 35 U.S.C. §102(e). Applicant will treat it as such.

Applicant respectfully traverses the rejection of claims 1, 3, 5, 9, 15, 20, 24, and 29 because, *inter alia*, Diamond does not teach “a radio frequency antenna embedded on a chip.” The Diamond reference teaches that “the microchip can be affixed to a foil strip provided with a loop serving as an antenna,” not an “antenna embedded on a chip.” In order to sustain a rejection

under 35 U.S.C. 102(e), the cited reference must teach each and every claim limitation. (See MPEP §2131). Moreover, “the identical invention must be shown in as complete detail as contained in the . . . claim.” (See MPEP §2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Diamond cannot, therefore, anticipate claims 1, 3, 5, 9, 15, 20, 24, and 29, because Diamond fails to teach each and every element of claims 1, 3, 5, 9, 15, 20, 24, and 29 for at least the reasons stated above. Applicant therefore respectfully requests that the rejection as to claims 1, 3, 5, 9, 15, 20, 24, and 29 be withdrawn.

Applicant has amended claims 2, 4, 10, 16, 21, and 25 and respectfully traverses the rejection of claims 2, 4, 10, 16, 21, and 25 because the Diamond does not teach “granting access to a memory based on a security key.” The present application teaches a security management unit that checks and validates cryptographic keys that are sent to a cryptographic block. The cryptographic block stores the keys and these keys are checked and validated to grant or deny access to the memory chip, as described on page 4, lines 15-18.

In order to sustain a rejection under 35 U.S.C. 102(e), the cited reference must teach each and every claim limitation. (See MPEP §2131). Moreover, “the identical invention must be shown in as complete detail as contained in the . . . claim.” (See MPEP §2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Diamond cannot, therefore, anticipate claims 2, 4, 10, 16, 21, and 25 because Diamond fails to teach each and every element of claims 2, 4, 10, 16, 21, and 25 for at least the reasons stated above. Applicant therefore respectfully requests that the rejection as to claims 2, 4, 10, 16, 21, and 25 be withdrawn.

Applicant respectfully traverses the rejection of claims 6 and 35 because Diamond does not teach attaching an identification mechanism to a license plate or any other part of a vehicle. The cited text in the Diamond reference teaches attaching or embedding an identification mechanism to a variety of objects, such as a boarding pass, baggage tag, bracelet, identity card, or driver's license. However, the Diamond reference does not teach attaching an identification mechanism to a vehicle license plate as required by claims 6 and 35. Diamond cannot, therefore, anticipate claims 6 and 35 because Diamond fails to teach each and every element of claims 6 and 35 for at least the reasons stated above. Applicant therefore respectfully requests that the rejection as to claims 6 and 35 be withdrawn.

Claims 7, 8, 11-14, 17-19, 22, 23, 26, 27, 30, 32, 34, 36, 38, 40, 41, 49 and 51 depend directly or indirectly, from allowable claims discussed above and thus are allowable for at least the same reasons as discussed above with respect to those claims. Applicant therefore respectfully requests that the § 102 rejections be withdrawn.

Claim Rejections Under §103:

Paragraph 3 of the Office Action rejects claim 28 under 35 U.S.C. 103(a) as being unpatentable over Diamond in view of Stilp (U.S. Patent No. 6,334,059). Applicant respectfully traverses the rejection as to claim 28, because, *inter alia*, Diamond and Stilp, alone or in combination, fail to render the claims unpatentable.

In rejecting original claim 28, the Office Action primarily relies on Diamond. The Office Action admits, however, that Diamond fails to teach all of the limitations of claim 28. Accordingly,

Diamond cannot render claim 28 unpatentable, because as the Office Action admits that, Diamond fails to teach, suggest, or disclose each and every element of claim 28.

The Office Action must, therefore, rely Stilp to make up for the deficiencies of Diamond. The references referred to do not, however, support a *prima facie* case of obviousness because, *inter alia*, none of the references teaches verifying that a user is authorized to download a software application using a chip with a radio frequency antenna as taught by the present application and claimed in claim 28. Moreover, none of the references include a motivation to combine the references to achieve the specific combination of original claim 28. Similarly, none of the reference include any indication that one would be successful in achieving the specific invention as claimed in original claim 28 by combining the references.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” (See MPEP §706.02(j)).

In this instance, the Office Action fails to meet all three requirements necessary to sustain a *prima facie* case of obviousness. First, the references cited by the Office Action fail to teach each and every claim limitation. In fact, the Office Action admits that Diamond, the primary reference, fails to teach, suggest or disclose verifying that a user is authorized to download a

software application using a chip with a radio frequency antenna. The Office Action indicates that Stilp teaches verifying that a user is authorized to download a software application using a chip with a radio frequency antenna, however, applicant has reviews Stilp and applicant believes that Stilp does not teach authorizing a download of software. Stilp teaches adding or deleting applications from a tasking list. It is clear from the cited text that editing task lists is not the same as described in the present application and required by claim 28. Accordingly, the references cited in the Action, alone or in combination cannot sustain a *prima facie* case of obviousness, because the reference do not teach each and every limitation of amended claim 28.

Second, the rejection must fail because the references themselves fail to provide a motivation to combine, or modify, the teachings of the references or a likelihood that one would be successful if one did combine, or modify, the teachings of the cite references. As noted above, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the [cited] prior art and not based on applicant's disclosure. (*See Id.*). In this case, the rejection fails to point to any teachings contained in the cited references that suggest a motivation to combine or a likelihood of success.

Each finding of fact upon which a conclusion of obviousness is based must be supported by substantial evidence and, in particular the conclusion that the prior art suggests or motivates the modification of a prior art reference must be based on findings supported by substantial evidence. (*In re Kotzab*, 217 F. 3d 1365, 1370-71 (Fed. Cir. 2000)). Hence, a *prima facie* case of obviousness cannot be made out by merely asserting that modifications to the prior art are “well within the ordinary skill of the art.” (*Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)). Accordingly, Applicant asserts that the Action fails to make out a *prima facie* case of obviousness, because it fails to provide the required substantial evidence in support

of the conclusion that the cited references teach a motivation to modify the teachings of Diamond with the teachings of Stilp. Due to the deficiencies of the cited reference, Applicant believes that amended claim 28 is in condition for allowance and respectfully requests withdrawal of the rejection as to claim 28.

Paragraph 4 of the Office Action rejects claims 31 and 37 under 35 U.S.C. 103(a) as being unpatentable over Diamond. Applicant respectfully traverses this rejection because claim 31 depends from allowable claim 29. Accordingly, claim 31 is allowable for at least the same reasons discussed above with respect to claim 29. Applicant therefore respectfully requests that the § 103(a) rejection as to claim 31 be withdrawn. Claim 37 depends from claim 35.

Accordingly, claim 37 is allowable for at least the same reasons discussed above with respect to claim 35. Applicant therefore respectfully requests that the § 103(a) rejection as to claim 37 be withdrawn. Diamond does not teach attaching the identification object to any part of a vehicle.

Paragraph 5 of the Office Action rejects claims 33, 39, and 42-48 under 35 U.S.C. 103(a) as being unpatentable over Diamond in view of O'Brien (U.S. patent No. 6,203,952). Applicant respectfully traverses this rejection as to claim 33 because claim 33 depends from claim 29, unless O'Brien makes up for the deficiencies of Diamond, which it does not.. Accordingly, claim 33 is allowable for at least the same reasons discussed above with respect to claim 29, unless O'Brien makes up for the deficiencies of Diamond, which it does not. Applicant therefore respectfully requests that the § 103(a) rejection as to claim 33 be withdrawn.

Applicant respectfully traverses this rejection as to claim 39 because claim 39 depends from claim 35. Accordingly, claim 39 is allowable for at least the same reasons discussed above with

respect to claim 35. Applicant therefore respectfully requests that the § 103(a) rejection as to claim 39 be withdrawn.

Applicant respectfully traverses the rejection as to claims 42-48, because, *inter alia*, Diamond and O'Brien, alone or in combination, fail to render the claims unpatentable.

In rejecting claims 42-48, the Office Action primarily relies on Diamond. The Office Action admits, however, that Diamond fails to teach all of the limitations of claims 42-48. Accordingly, Diamond cannot render claims 42-48 unpatentable, because as the Action admits, Diamond fails to teach, suggest, or disclose each and every element of claims 42-48.

The Office Action must, therefore, rely O'Brien to make up for the deficiencies of Diamond. The references referred to do not, however, support a *prima facie* case of obviousness because, *inter alia*, neither of the references teaches a retroreflective integrated circuit-sealed product, and an integrated circuit as taught by the present application and claimed in claims 42-48. The cited text indicates that "[p]atterned optical surface layers made in accordance with the teachings of O'Brien can be used with reflective materials. Claims 42-48 are not directed to methods for patterning optical surface layers on retroreflective material as taught in O'Brien and O'Brien does not teach a retroreflective integrated circuit-sealed product, and an integrated circuit as taught by the present application. Accordingly, O'Brien cannot make up for the deficiencies of Diamond.

The Office Action attempts to make up for the deficiencies of both references with respect to the identification mechanism being a retroreflective by stating that "it would have been obvious to one of skill in the art at the time the invention was made to adapt the RFID smart card of Diamond to use on the retroreflective materials such as O'Brien since the material of the smart

card and antenna are made of conductive layer and non-conductive layers for preventing of physical damage to the smart card as well as to minimize of electromagnetic interference.” Such a statement cannot make up for the deficiencies of the cited references, however, because the statement completely ignores the requirement that the prior art reference (or references when combined) must themselves teach or suggest all the claim limitations. (*See Id.*)

Due to the deficiencies of the cited reference, Applicant believes that amended claims 42-48 is in condition for allowance and respectfully requests withdrawal of the rejection as to claim 42-48.

Paragraph 6 of the Office Action rejects claims 50 and 52 under 35 U.S.C. 103(a) as being unpatentable over Diamond in view of Janssen (U.S. Patent No. 6,427,504). Applicant respectfully traverses this rejection because claim 50 depends from claim 1. Accordingly, claim 50 is allowable for at least the same reasons discussed above with respect to claim 1, unless Janssen makes up for the deficiencies of Diamond, which it does not.. Applicant therefore respectfully requests that the § 103(a) rejection as to claim 50 be withdrawn. Claim 52 depends from claim 2. Accordingly, claim 52 is allowable for at least the same reasons discussed above with respect to claim 2, unless Janssen makes up for the deficiencies of Diamond, which it does not.. Applicant therefore respectfully requests that the § 103(a) rejection as to claim 52 be withdrawn.

CONCLUSION

Applicant believes that given the above amendments and remarks, the claims are now in condition for allowance and such is respectfully requested. The Examiner is requested to charge these and any additional fees that may due with this response to deposit account 13-0480.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Howard N. Wisnia", is written over a horizontal line.

Howard N. Wisnia
Reg. No. 37,502
Baker & McKenzie
2001 Ross Avenue, Suite 2300
Dallas, Texas 75201
Telephone (619) 235-7750
Facsimile (214) 978-3099